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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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D 88652-60270

020873  
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HM12/0214

EXAMINER

BULEY, J

ART UNIT

PAPER NUMBER

DATE MAILED:

02/14/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/612,894**

Applicant(s)  
**Stocco et al.**

Examiner  
**Jezia Riley**

Group Art Unit  
**1656**



☒ Responsive to communication(s) filed on Jan 23, 2001

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 14-17 and 37-40 is/are pending in the application.

Of the above, claim(s) 1-13 and 18-36 are canceled is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 14-17 and 37-40 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

**DETAILED ACTION**

1. Applicant's election without traverse of Group I and cancellation of claims 1-13 and 18-36 in paper No. 5 is acknowledged.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the 35 U.S.C. § 112, 1<sup>st</sup> paragraph:

*The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.*

3. Claims 37-40 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a stereoidogenic protein having the exact sequence of SEQ ID NO:2-8 does not reasonably provide enablement for a protein having an amino acid sequence essentially as set forth in SEQ ID NO:2-8. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. There is no guidance in the specification regarding the making of alternative species that include changes to the sequence that encodes a protein having the amino acid sequence of SEQ ID NO:2. The phrase "essentially as set forth in SEQ ID NO:2", for example, may mean "approximately" or "about". Therefore undue experimentation is required to make and use the invention as broadly claimed.

4. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

*The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.*

5. Claims 14-17, 37-40 are rejected under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph.

Claims 14-17 are indefinite because it is unclear in claim 14 line 1, for example if the word "having" should be interpreted as "consisting of" (closed claim language) which means the applicant claims exactly the SEQ ID. No:2; or the word "having" should be interpreted as "comprising" (open claim language) which means only a certain percentage (maybe not 100%) of SEQ ID. No:2, for example. If the applicant would like to claim an exact sequence without substitution or insertion, the word "contiguous" and the phrase "consisting of" should be used in the claims.

Claims 37-40 are vague and indefinite because the phrase "essentially as set forth in SEQ ID NO:2", for example, is used. It is unclear if the steroidogenic acute protein has the exact sequence of SEQ ID NO:2, 3, 4, 5, 6, or 8 or the steroidogenic acute protein is different in length from the SEQ ID NO:2, etc. The phrase "essentially as set forth in SEQ ID NO:2" may mean for example "approximately" or "about".

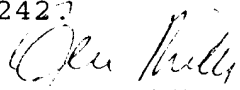
6. No claim is allowed.

#### Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jezia Riley whose telephone number is (703) 305-6855. The Examiner may normally be reached Monday through Friday, 0900 - 1700 EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Gary Jones, may be reached at (703) 308-1152.

Any inquiry of a general nature or relating to the status of this application should be directed to the Chemical Matrix Receptionist whose telephone number is (703) 308-0196.

Any necessary fax can be sent to (703) 308-4242.

  
JEZIA RILEY  
PRIMARY EXAMINER